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REMARKS

Claims 12-16 and 19-33, remain pending in the above-identified application. In view of the earlier amendments and the following remarks, it is respectfully submitted that all pending claims are allowable.

The Rejection of Claims 12-16, 19-21, 23-29 and 31-33 under 35 U.S.C. § 103(a) should be withdrawn

Claims 12-16, 19-21, 23-29 and 31-33 stand rejected under 35 U.S.C. § 103(a). The Patent Office has contended that these claims are unpatentable over Park (U.S. Patent Publication No. 2005/0155690) (hereinafter Park) in view of Ongena (U.S. Patent No. 4,668,460) (hereinafter Ongena).

Applicants respectfully submit that Claims 12-16, 19-21, 23-29 and 31-33, are not unpatentable over Park in view of Ongena for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990), cert. denied 111 S.Ct. 296 (1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. § 2143. Applicants respectfully submit that neither of these criteria for obviousness are met here.

Park (U.S. Patent Publication No. 2005/0155690) (hereinafter Park) has a filing date of January 16, 2004, which date is not more than one year from Applicants' filing

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date of September 28, 2004, and therefore Park is not a proper prior art reference and the Applicants respectfully request that the Patent Office withdraw Park as an applied reference.

In the event that the Patent Office refuses to withdraw Park as an applied reference the Applicants argue that Park is not a proper reference as Park in paragraph 108, teaches that composite "articles are made of rubber composition" and which are then "adhered to a substrate" using an "adhesive layer" and where the "adhesive layer may be provided on the substrate prior to contact with the partially cured thermoplastic vulcanizate" and that "the adhesive layer will contain coupling agents that tend to react with one or both surfaces to be joined and increase the bond strength," which is very different than what is being disclosed and claimed by the Applicants.

Ongena (U.S. Patent No. 4,668,460) (hereinafter Ongena) teaches a method of molding and coating a substrate in a mold, which is very different than what is being disclosed and claimed by the Applicants.

In fact, a combination of Park with Ongena would destroy Ongena's invention as Ongena clearly teaches in Col. 2, Lines 32-34, that the "coating is injected into the mold at a high pressure without reopening or reclosing the mold," while Park clearly teaches in paragraph 121, that the "layer may be sprayed on, or the housing may be dipped or immersed."

Furthermore, Applicants in Claims 12 and 24, discloses a process for preparing a multi-layer article, by placing a substrate in a mold, and wherein said substrate alone is first pre-cured to an incomplete state of cure in said mold at a temperature of 75 to 125 C, which is neither taught nor disclosed by either Park or Ongena, either alone or in combination.

Additionally, neither Park nor Ongena, either alone or in combination, disclose that "an uncured fluoroelastomer layer of less than or equal to 0.3 mm thickness" be "placed on said pre-cured substrate of step (a) and said layers are cured together in said mold ... to form an intermediate article," as disclosed and claimed by the Applicants.

Similarly, neither Park nor Ongena disclose that "removing said intermediate article of step (b) from said mold and curing it in an oven at a temperature ... such that

the cross linking of the layers forms a permanent bond between said substrate and said fluoroelastomer layer and thereby forming said multi-layer article,” as disclosed and claimed by the Applicants.

In fact, Ongena teaches away from Applicants’ invention when in Col. 2, Lines 23-25, he teaches that it “would be highly desirable to eliminate the secondary opening and closing of the dies from an efficiency and flexibility point of view,” and that the “coating is injected into the mold at a high pressure without reopening or reclosing the mold”. (Col. 2; Lines 32-34.)

Park also teaches away from Applicants’ invention when in Paragraphs 120 and 121, he teaches to grind “a chunk of the batch process TPV for injection molding or extrusion process” where TPV is “a homogenously mixed and partially cured thermoplastic vulcanizate (TPV),” which process is very different than what is being disclosed and claimed by the Applicants.

Park also teaches away from Applicants’ invention when in Paragraph 121, he teaches to prepare “silane based adhesion coated metal housings for insert molding operations,” where an “adhesive layer may be sprayed on, or the housing may be dipped or immersed in the adhesive,” and to insert “an adhesive coated metal housing in the mold,” which process is very different than what is being disclosed and claimed by the Applicants.

Park also teaches away from Applicants’ invention when in Paragraphs 121, he teaches that “TPV material is injected ... onto the adhesive-coated metal housing and held together under pressure ... to allow adhesive layer and molten TPV material to contact together and react to promote a bonded layer,” which process is very different than what is being disclosed and claimed by the Applicants.

The Applicants would also like to respectfully state that Park in view of Ongena does not overcome the deficiencies of the prior art, for example Park in view of Ongena does not teach the placement of “a substrate in a mold, and wherein said substrate alone is first pre-cured to an incomplete state of cure in said mold,” and that “an uncured fluoroelastomer layer of less than or equal to 0.3 mm thickness is placed on said pre-cured substrate” and that “said layers are cured together in said mold ... to form an

intermediate article,” as disclosed and claimed by the Applicants in Claims 12-16, 19-21, 23-29 and 31-33.

Additionally, there is no teaching in Park or Ongena that the substrate be coated with a thin uncured fluoroelastomer film or layer of 0.3 mm or less, as disclosed and claimed by the Applicants in Claims 12-16, 19-21, 23-29 and 31-33.

In light of these facts Applicants respectfully submit that Park in view of Ongena does not make unpatentable the invention of independent Claims 12 and 24.

Claims 13-16, 19-21, and 23, and 25-29 and 31-33, depend from, and include all the limitations of Claims 12 and 24, respectively, and therefore these claims are not unpatentable over Park in view of Ongena.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claims 12-16, 19-21, 23-29 and 31-33, is hereby respectfully requested.

The Rejection of Claims 22 and 30 under 35 U.S.C. § 103(a) should be withdrawn

Claims 22 and 30 stand rejected under 35 U.S.C. § 103(a). The Patent Office has contended that these claims are unpatentable over Park (U.S. Patent Publication No. 2005/0155690) (hereinafter Park) in view of Ongena (U.S. Patent No. 4,668,460) (hereinafter Ongena), as applied above, and further in view of admitted prior art (“Admission”).

Applicants respectfully submit that Claims 22 and 30, are not unpatentable over Park in view of Ongena, and further in view of “Admission,” for at least the following reasons.

The earlier criteria to be applied for a claim to be rejected for obviousness under 35 U.S.C. § 103(a) is incorporated herein by reference.

The earlier arguments with reference to Park and Ongena are also incorporated herein by reference.

Furthermore, it is not clear which admitted prior art (“Admission”) the Patent Office is referring to in Applicants’ specification. The Applicants are assuming that the

Patent Office is referring to Paragraph 7 of the instant application where the Applicants have clearly differentiated U.S. Patent No. 6,759,129, from Applicants' invention, and where Applicants have clearly stated that "we have proven that it is not necessary to use a bonding agent to attach thin fluoroelastomer film to a substrate such as EPDM or Nitrile rubber through the use of a three stage cross linking method." Thus it is not clear how the Patent Office is combining Applicants' "Admission" with two completely unrelated, applied, prior art references.

Furthermore, the Patent Office has also not established a motivation for such a combination between Park in view of Ongena, and further in view of "Admission," to teach or disclose Applicants' invention of Claims 22 and 30.

Additionally, the "Admission" became prior art only upon the filing and subsequent publication of Applicants' patent application and thus is not a prior art under 35 U.S.C. § 103(a).

In light of these facts Applicants respectfully submit that Park in view of Ongena, and further in view of Applicants' "Admission," does not make unpatentable the invention of independent Claims 12 and 24.

Claims 22 and 30, depend from, and include all the limitations of Claims 12 and 24, respectively, and therefor these claims are not unpatentable over Park in view of Ongena, and further in view of Applicants' "Admission."

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claims 22 and 30, is hereby respectfully requested.

CONCLUSION:

It is therefore respectfully submitted that Claims 12-16 and 19-33, as amended, are now all allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Applicants have reviewed the cited but unapplied art and cannot respond as the Examiner has not applied said prior art.

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The Examiner is also invited to contact the undersigned attorney if any communication is believed to be helpful in advancing the examination of the present application.

Respectfully submitted,

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By:



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